

### REMARKS

In the Office Action mailed July 14, 2004, claims 10-35, 47, and 48 were rejected. Claims 15, 17-34 and 47 have been canceled without prejudice. Claims 10-14, 16, 35 and 48 are now pending in the application. In view of the remarks, Applicants respectfully request reconsideration of the application.

#### **Rejections under § 112**

Examiner states that there is no disclosure that the "each page of the coloring book is printed on a single surface" and "the storyboard is printed on a single surface." For the sake of brevity and clarity, Applicants do not address the support for "each page of the coloring book is printed on a single surface", because claims directed to the coloring book printed on a single surface are canceled.

Applicants respectfully disagree with the Examiner's statement that there is no disclosure for the following: "the storyboard is printed on a single surface." Applicants cite Figure 8 and page 11, line 16 to page 12, line 6 of the specification for teaching a storyboard 800 having multiple images that are selected by the user. Applicants cite page 12, line 19 to page 13, line 3 of the specification for teaching printing the storyboard in a single surface. For example, the specification states, "line-art image 500 may be formatted with stock images 320 to generate coloring book storyboard 800." Further, the specification states, "In another alternate embodiment, coloring book storyboard 800 may be printed." In addition, the specification states, "coloring book image 600 is printed at client 105, 115. In another alternate embodiment, coloring book storyboard 800 may be printed." (specification, page 14, lines 3-8)

Applicants believe that a person skilled in the relevant art would understand that “the storyboard is printed on a single surface” rather than on multiple surfaces.

Examiner states that in Claims 17 and 21 the word “pace” is unclear. Applicants canceled Claims 17 and 21.

### **Rejections under § 103**

Claims 10, 13-20, 34, 35, and 48 were rejected under U.S.C. § 103(a) as being unpatentable over US Patent No. 6,356,274 (hereinafter Spector) in view of US Patent No. 6,373,551 (hereinafter Manico) and US Patent No. 6,099,928 (hereinafter Chee). Applicants respectfully disagree. Applicants respond to the Examiner’s Response to Arguments under a separate heading below.

Chee discloses a transparency mat card comprising a mat with a window and a transparency mounted in the window using a weak, removable glue applied to portions of a glue border so that the transparency can be detached intact from the mat card. A picture or other visual pattern is preferably printed or otherwise marked on the transparency, preferably on the rear surface. (Abstract)

Chee further discloses that messages or greetings can be written on either side of the back portion of the card. Messages such as doodles, extra notations, advertisements, or announcements may be written on the front portion of the card as well. Messages or decorative elements may be added to the transparency or to the mat card by the manufacturer, or by the consumer, or by the consumer in concert with the manufacturer (as in coloring books, or “paint by number” works). (col. 3, lines 15-23)

Chee further discloses that the designs are printed by means of a printer on a clear medium such as an acetate. Each original picture is then trimmed by hand or machine so as to conform to the dimensions of the mat card windows.

(col. 7, lines 39-57) Applicants believe that Chee teaches the use of multiple image wherein each image is printed in a separate surface. Further, Applicants also believe Chee teaches the use of separate surfaces for the transparency and the mat card.

Applicants believe that Spector in view of Manico and Chee fail to hint, suggest, nor teach (either singly or in combination) the automatic creation of a coloring book or story board both containing multiple coloring book images on a single surface.

In marked contrast, claims 10, 35, and 48 disclose the creation of a story board which is composed of a plurality of coloring book images on a single surface. Accordingly, independent claims 10, 35, and 48 are now in condition for allowance. In addition, claims 13, 14, and 16 depend directly or indirectly on independent claim 10, and therefore, are patentable for at least the same reasons discussed above.

Claims 11-12 were rejected under U.S.C. § 103(a) as being unpatentable over Spector in view of Manico and Chee and further in view of EP 0713788. Claims 11-12 depend directly or indirectly on independent claim 10, and therefore, are patentable for at least the same reasons discussed above.

Claims 21, 22, 26, 31, 32, 33, and 47 were rejected under U.S.C. § 103(a) as being unpatentable over Spector in view of Chee. Claims 21, 22, 26, 31, 32, 33, and 47 are canceled.

Claims 23-25 were rejected under U.S.C. § 103(a) as being unpatentable over Spector in view of Chee and further in view of EP 0713788. Claims 23-25 are canceled.

Claims 27-30 were rejected under U.S.C. § 103(a) as being unpatentable over Spector in view of Chee and further in view of Manico. Claims 27-30 are canceled.

## **Response to Arguments**

The Examiner submits that Chee discloses a storybook containing a plurality of image. The Applicants agree. However, Applicants respectfully disagree with the Examiner's reasoning for rejecting the independent claims. Applicants submit that according to Chee each original picture is then trimmed by hand or machine so as to conform to the dimensions of the mat card windows. (col. 7, lines 39-57) Applicants believe that Chee teaches the use of multiple images wherein each image is printed in a separate surface. Further, Applicants also believe Chee teaches the use of separate surfaces for the transparency and the mat card.

For example, even though the Applicants acknowledge that Chee discloses a storyboard with a plurality of images, Chee fails to disclose story board printed on a single surface" as shown in Claims 10, 35, and 48. Chee teaches a storyboard printed with each image on a separate surface.

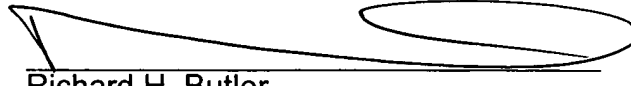
The Examiner submits Figure 4 and col. 40-57 of Chee for support. However, Applicants respectfully call attention to the following: "six original prints, pictures, or photographs 32, 34, 36, 38, 40, 42 are laid out in such a manner that pairs..." (Chee, col. 7, lines 40-42); and "Each original image is then trimmed by hand or machine so as to conform to the dimensions of the preferred mat card window(s) and to provide for any necessary glue border." (Chee, col. 7, lines 54-57) Accordingly, Applicants submit that Chee teaches a storyboard with each print, picture or photograph having a different surface and differs from Claims 10, 35, and 48.

In view of the foregoing amendments and remarks, Applicants respectfully submit that all pending claims are in condition for allowance. Such allowance is respectfully requested.

If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to contact Richard H. Butler at (408) 223-9763.

Respectfully submitted,

Dated: 10/14/04

A handwritten signature in black ink, appearing to be 'Richard H. Butler', written over a horizontal line.

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